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| 09/761,031      | 01/16/2001  | Richard E. Rowe      | 29757/P-265         | 4234             |

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MARSHALL, GERSTEIN & BORUN LLP  
233 S. WACKER DRIVE, SUITE 6300  
SEARS TOWER  
CHICAGO, IL 60606

EXAMINER

SHAH, MILAP

ART UNIT PAPER NUMBER

3714

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/761,031

Applicant(s)

ROWE, RICHARD E.

Examiner

Milap Shah

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION**

This action is in response to amendment filed July 28, 2005. The Examiner acknowledges that claims 1, 9, 17, 25, 34, 41 & 50 were amended, no claims were canceled, and no new claims were added. Therefore, claims 1-54 are currently pending. This action is being made NON-FINAL to afford the Applicant the opportunity to respond to the new grounds of rejection presented below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, 31, 33, 34, 39, 41, 46, & 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (U.S. Patent 6,089,976).

**Claims 1, 9, 17, 25, 41, & 50:** Schneider et al. disclose a slot machine that teaches the following features of the claims:

- a. A color display unit capable of generating images associated with a main gambling game and bonus round game (figure 6[14, 16] & column 4, lines 28-46).
- b. An input device allowing the user to make a plurality of input selections (figures 6[14, 16], 26).
- c. A currency-accepting mechanism that is capable of allowing users to deposit a medium of currency (figures 5[22-25], 6[18]).

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- d. A value-dispensing mechanism that is capable of dispensing value to a user (figures 5[22-25], 6[37,38]).
- e. A controller operatively coupled to the display unit, the input device, the currency-accepting mechanism, and the value dispensing mechanism where the controller comprises a processor and a memory operatively coupled to the processor (figure 6[60] & column 4, line 64 – column 5, line 33).
- f. The controller being programmed to allow the user to make a wager via the input device after the currency-accepting mechanism detects deposit of currency by the user (column 5, lines 34-55).
- g. The controller being programmed to cause the display unit to display a first sequence of images representing a main gambling game after the user makes a wager, the first sequence of images representing a main gambling game of video poker or video slots and at least one of the images comprising an images of at least five playing cards (column 5, lines 8-10).
- h. The controller being programmed to determine, after the first sequence of images has been displayed, an outcome of the main game represented by the first sequence of images and to determine a currency payout associated with the outcome of the main gambling game (column 4, line 64 – column 5, line 33).
- i. The controller being programmed to cause a second sequence of images to be generated on the display after detecting the triggering event, the second sequence of images representing a bonus round game. See col. 3:27-46, 5:56-64.
- j. The controller being programmed to determine, after the second sequence of images has been displayed, an outcome of the bonus round game represented by the second

sequence of images and to determine a bonus payout associated with the outcome from the bonus round game. See *id.*

k. The controller being programmed to cause the value-dispensing mechanism to dispense the bonus payout and not the currency payout to the user after the bonus payout has been determined and prior to returning to the main gambling game. See *id.*

l. The controller being programmed to return to the main gambling game at the conclusion of the bonus round game.

Schneider et al. lack specifically disclosing user selection is used to determine whether the bonus payout and not the currency payout is dispensed to the user or added to the available credits for the user. However, Schneider et al. does in fact disclose dispensing the bonus payout and adding the bonus payout to a credit meter, but does not disclose both options within one embodiment, though, the teachings are available. One of ordinary skill in the art would deem it well known at the time the invention was made to allow for user selection or intervention to create interactive and exciting games for users which entice continuous game play that generates revenue for gaming establishments. Therefore, in view of the teachings to dispense a bonus payout or add it to a credit meter, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Schneider et al. to allow for user selection (i.e. using various methods including buttons or touch screens) to determine if a bonus payout is dispensed directly to a user or added to the user's credit meter in order to provide an interactive and exciting game that entices users to play the gaming machine while generating increased revenue for gaming establishments.

**Regarding claim 41:** Schneider et al. disclose the limitations as recited above in steps (a) – (l), including the obviousness of the bonus payout determined by user selection as

discussed above, except for having a separate memory configured to perform each of the functions above. It is well known in the art that programming code is utilized to execute the functions of the above recited steps, wherein the programming code is stored in a storage device (i.e. a memory), thus, each position of the programming code for each step as recited above, is considered to be stored in a separate “portion” of the memory. That is, for example, the memory portion that stores the program code for step (f) is considered the “first memory portion”, whereas a second portion storing step (g) is considered a “second memory portion.” Therefore, it would have been obvious to one of ordinary skill at the time of the invention to store program code in distinct memory portions. Storing program code in distinctly different “portions” of the memory allows for program organization and quick execution.

**Claims 2, 10, 18, 26 & 34:** Schneider et al. teach a currency-accepting mechanism comprises one of a coin slot, bill reader and electronic reader that is capable of reading an item having data stored thereon (column 4, lines 29-46).

**Claims 7, 15, 23, 31, 39 & 46:** Schneider et al. teach a triggering event being a qualifying outcome, which may be a combination of symbols (column 2, lines 60-62 & column 5, lines 40-47). A qualifying hand in a poker gaming device always consists of either a combination of symbols, a single symbol or a combination thereof.

**Claims 48 & 49:** Schneider et al. disclose a gaming device having programmed memory means for storing computer-readable instructions as discussed earlier (figure 6[64]).

However, Schneider et al. lack disclosing the programmed memory comprises of a semi-conductor memory or an optically readable memory. Regardless, it is notoriously well known in to use semi-conductor memory or an optically readable memory to store program

instructions in gaming devices. These types of memories are substitutable equivalents known in the art for the same purpose of storing computer-readable instructions in a non-volatile medium. Hence, it would have been obvious to an artisan at the time of the invention to modify the gaming device disclosed by Schneider et al., wherein a programmed memory stores computer-readable instructions, to substitute semi-conductor memory or an optically readable memory to store the computer-readable instructions in a non-volatile medium and thereby prevent loss or changes to the data.

Claims 3-5, 11-13, 19-21, 27-29, 35-37, 42-44, & 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al., as applied to claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, 31, 33, 34, 39, 41, 46 & 48-50, where applicable, further in view of Walker et al. (U.S. Patent No. 6,110,041).

**Claims 3, 5, 11, 13, 19, 21, 27, 29, 35, 37, 42, 44, 51 & 53:** Schneider discloses the invention substantially as claimed except dispensing the bonus payout based on user preference information stored on the item. Walker discloses a gaming system in which players' gaming machine preferences are associated with a tracking card (figures 9-11(b) & column 2, lines 13-53). Based on the players' preferences the slot machine can be configured according to operative according to the players' preferences of, for example, game type, language or form of payout (column 1, lines 55-65). In view of Walker, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming system described by Schneider et al. to add the feature of dispensing the bonus payout based on user preference information stored on the item. As suggested by Walker, configuring a gaming system based on player preference increases player interest while reducing their frustration.

*See id.* As a result, operator revenue would increase in accordance with increased player usage.

**Claims 4, 12, 20, 28, 36, 43 & 52:** Walker additionally teaches a player tracking system wherein the game controller is programmed to transmit data stored on a item to the player tracking system via an interface and to receive information related to the user associated with the item having data stored thereon from the player tracking system via the interface. *See id.*

Claims 6, 14, 22, 30, 38, 45, & 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al., as applied to claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, 31, 33, 34, 39, 41, 46 & 48-50, where applicable, further in view of Burns et al. (U.S. Patent 6,048,269) and Saunders et al. (U.S. Patent 6,340,331).

**Claims 6, 14, 22, 30, 38, 45 & 54:** Schneider discloses all the features of the claim except a value dispensing mechanism that is a printing apparatus and the dispense value is an award ticket printed and dispensed by the printing apparatus and having indicia of at least one of casino name, ticket type, a validation number, a bar code, a date of issuance, a time of issuance, redemption instructions, redemption restrictions, and a description of the award.

Burns discloses a coinless gaming system wherein the value dispensing mechanism is a printing apparatus and the dispensed value is an award ticket printed and dispensed by the printing apparatus and having indicia including casino name (i.e. logo), ticket type, a validation number, a bar code, a date of issuance, a time of issuance and a description of the award (figures 1-4). Saunders discloses a similar system wherein printed tickets additionally include redemption instructions and redemption restrictions (figures 1-3).



In view of Burns and Saunders, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify gaming system described Schneider to add a value dispensing mechanism that is a printing apparatus and the dispense value is an award ticket printed and dispensed by the printing apparatus and having indicia of at least one of casino name, ticket type, a validation number, a bar code, a date of issuance, a time of issuance, redemption instructions, redemption restrictions, and a description of the award. As suggested by Burns, the use of printed tickets enhances the gaming device by increasing convenience and security for both the players and operators (column 2, line 66 – column 4, line 26).

Claims 8, 16, 24, 32, 40 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al., as applied to claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, 31, 33, 34, 39, 41, 46 & 48-50, where applicable, further in view Adams (U.S. Patent 6,113,098).

**Claims 8, 16, 24, 32, 40 & 47:** The gaming system described Schneider discloses all the features of the claim except a value dispensed by the value dispensing mechanism being at least one of ticket redeemable for cash, a ticket for a show, a ticket for a meal, a ticket for casino services, a ticket for hotel services. Adams discloses a gaming system with a supplemental ticket dispenser wherein a gaming device that provides awards from a group consisting of coins, currency, credits or redeemable tickets (figure 1 & column 1, lines 32-46). The tickets may be redeemed for various goods or services including meals, rooms, shows and free game play (column 2, lines 34-47). In view of Adams, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming system described Schneider to add a value dispenser mechanism to dispense tickets

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redeemable for cash, a ticket for a show, a ticket for a meal, a ticket for casino services, a ticket for hotel services to enhance operators' revenues by marketing additional services to users by awarding them tickets redeemable for non-gaming goods and services and thereby induce users to spend more money at other portions operator's business.

### ***Response to Arguments***

Applicant's arguments, see pages 23-24, filed July 28, 2005, with respect to the rejection(s) of claim(s) 1-54 under 35 U.S.C. 102 and 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made using Schneider et al. in a 35 U.S.C. 103(a) rejection. The new grounds for rejection of claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, 31, 33, 34 and 39, necessitated the rejections of all dependent claims to change as well. Thus, all prior rejections under 35 U.S.C 102(b) and/or 35 U.S.C. 103(a) are withdrawn and the current rejections in this office action should be considered by Applicant.

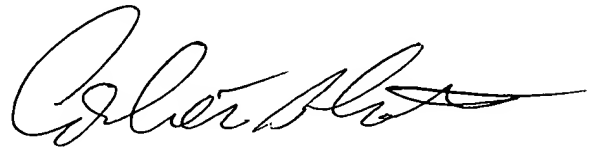
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Jones can be reached on (571) 272-4438. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.B.S.

A handwritten signature in black ink, appearing to read "Glen H. [unclear]", with a long horizontal flourish extending to the right.